UNITED STATES PATENT AND TRADEMARK OFFICE

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HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

EXAMINER
YAARY, MICHAEL D

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GASTON M. BARAJAS, WILLIAM P. HYDEN,
GAVIN T. SMITH, and THOMAS VRHEL JR.

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Appeal 2009-005451[1]
Application 10/657,374
Technology Center 2100

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Decided: May 11, 2010

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Before JAMES D. THOMAS, JEAN R. HOMERE, and THU A. DANG,
Administrative Patent Judges.

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] Filed September 8, 2003. The real party in interest is Dell Products LP.
(App. Br. 1.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1 through 3, 5 through 13, 15 through 23, and 25 through 30. Claims 4, 14 and 24 have been canceled. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

As depicted in Appellants' Figure 1, Appellants invented a method and system (100) for automatically installing a software image onto a target information handling system (120). (Spec. 5, ll. 10-12.) As shown in Figure 3, upon receiving a reading order (310) from a customer to purchase the information handling system (120), an integrated rapid install system (300) reads an image manifest associated with the order to determine which software components to install on the system. (*Id.* at 8, ll. 6-13.) After installing the specified software components, the rapid install system configures the installed software while checking for the presence of subtract components among the specified software components in order to delete the subtract components, if any. (*Id.* at 8, l. 22 - 9, l. 9.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method for automatically installing a software image onto an information handling system, the method comprising:

reading an order for an information handling system;

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reading an image manifest;

installing an image specified by the image manifest onto the information handing system as installed software;

automatically configuring the installed software;

determining whether any subtract components are present in the image; and, if any subtract components are present, then removing the subtract components from the installed software while automatically configuring the installed software.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

| Cohen | 2003/0233646 A1 | Dec. 18, 2003 |
| Burkhardt | 6,823,508 B1 | Nov. 23, 2004 |

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 1 through 3, 5 through 13, 15 through 23, and 25 through 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Burkhardt and Cohen.

Appellants' Contentions

Appellants contend that the combination of Burkhardt and Cohen does not teach or suggest upon detecting the presence of subtract components among installed software components, removing the subtract components while configuring the installed software, as recited in independent claim 1.

(App. Br. 4-6.) According to Appellants, while the proffered combination discloses a machine specific configuration of a software, it does not teach or suggest removing detected software components from an installed software image while automatically configuring the software. (*Id.* at 6.)

Examiner's Findings

The Examiner finds that Cohen's disclosure of performing an image configuration including adding and removing software components teaches the claimed limitation. (Ans. 7.)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Burkhardt and Cohen teaches or suggests upon detecting the presence of subtract components among installed software components, removing the subtract components while configuring the installed software?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Burkhardt

1.   Burkhardt discloses a system for automatically customizing the operating system software to be installed on a computer according to a user's profile. (Abst.) As depicted in Figure 2, a bill of material (BOM-108) (containing the user's identity, hardware and software preferences) is utilized to customize the operating system (102) for the prospective user of

the computer (120). (Col. 3, ll. 41-67, col. 4, ll. 4-8.) Each component in the BOM corresponds to a manifest that identifies other related components, as well as those components that are installed or to be installed on the computer (120) as the operating system (102). (*Id.*) The BOM (108) can therefore be used to determine what components are installed on the operating system (102) of the computer (120). (Col. 4, 47-54.)

2.   Burkhardt discloses a BOM interface (110) that allows the setup application program (106) to retrieve data from the BOM (108) to modify data in the BOM and/or to add data in the BOM in order to customize the operating system for the user of the computer. (Col. 4, ll. 9-29.)

3.   As shown in Figure 4, upon receiving an order or a request (170) from a prospective user of the computer (176), a software installation station (178) copies the user's BOM, installs and customizes the operating system of the computer based on the copied BOM. (Col. 6, ll. 52-67.) The installation and customization of the operating system can be performed concurrently. (Col. 8, ll. 41-54.)

Cohen

4.   Cohen discloses a method and system for installing a software program on a computer based on a whole image of the software program, as opposed to a plurality of individual software components. In the case of an operating system software, an image of the software is applied to the target computer and used for subsequent customization according to the preferences of a user. (Paras. [0005]-[0006].)

5.   After applying the software image to the target computer, a further configuration or integration is performed to add or remove components from the image. (Para. [0054].)

IV. PRINCIPLES OF LAW

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

V. CLAIM GROUPING

Appellants argue the patentability of claims 1 through 3, 5 through 13, 15 through 23, and 25 through 30 in conjunction with the rejection of independent claim 1. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), we will consider these claims as standing or falling respectively with claim 1.

VI. ANALYSIS

Independent claim 1 requires, in relevant part, upon detecting the presence of subtract components among installed software components,

removing the subtract components while configuring the installed software.

(App. Br. 8, Claims App'x.)

We first consider the scope and meaning of the terms "*subtract*

components," which must be given the broadest reasonable interpretation

consistent with Appellant's disclosure, as explained in *In re Morris*,

127 F.3d 1048 (Fed. Cir. 1997):

> [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating

that "claims must be interpreted as broadly as their terms reasonably

allow."). Appellants' Specification states the following:

> During step 330, the integrated rapid install system 300 determines whether there are any subtract components present in the order. Subtract components are components that are present in the image that are not included within the order, and thus are to be deleted while the image is installed onto the target system 120. If there are any subtract components present in the order, then the integrated rapid install system 300 executes uninstall scripts for the subtract components that are missing from the order at step 332. The integrated rapid install system 300 then determines whether any script failures arose during the execution of the scripts at step 334. If a script failure did occur, then the integrated rapid install system 300 indicates a failure to the gatekeeper at step 320. If there were no script failures, then the integrated rapid install system 300 transfers to step 340.

(Spec. 8, l. 29 - 9, l. 9.)

Our reviewing court further states, "the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005).

Upon reviewing Appellants' Specification, we find the claim terms "*subtract components*" are defined as components that are present in the image of a software, that are not included within the order, and that are to be deleted while the image is installed onto the target system. We therefore construe the cited claim terms in accordance with their ordinary meaning as provided in hereinabove.

As set forth in the Findings of Fact section, Burkhardt discloses upon receiving an order from a consumer, automatically customizing an operating system software for use in a computer by installing thereon components of the software specified in the consumer's bill of material. (FF. 1-2.) Burkhardt also discloses that the consumer can modify the bill of material by adding or removing software components. (FF. 2-3.) Further, Cohen discloses customizing an operating system of a computer by first installing an image of software to the computer, and by subsequently configuring the installed software to add or remove image components therefrom. (FF. 4-5.)

We find that by specifying in the order or the bill of material the software components that are to be installed on the computer, Burkhardt impliedly teaches or suggests that any component not particularly specified in the bill of material is not to be installed on the computer. We further find that Cohen's disclosure of a software configuration process during which certain image components are removed from a software program installed on

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the computer complements Burkhardt's teachings. While Cohen's disclosure does not particularly indicate which image components are removed from the installed software, one of ordinary skill in the art would readily appreciate that unspecified components that are not in the consumer's order or the bill of material, as disclosed in Burkhardt, would need to be removed from the computer when used in combination with Cohen's disclosure. Therefore, we find that components not specified in Burkhardt's order or bill of material, that are yet installed on Cohen's computer, teaches the subtract components as construed hereinabove. Additionally, we find that by removing such subtract components from the installed software program during the software configuration, the proffered combination teaches, or at least suggests, upon detecting the presence of subtract components in the installed software, removing such components while the installed software is being configured. It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Burkhardt and Cohen renders independent claim 1 unpatentable.

VII. CONCLUSION OF LAW

Appellants have not established that the Examiner erred in rejecting under 35 U.S.C. § 103(a) claims 1 through 3, 5 through 13, 15 through 23, and 25 through 30 as being unpatentable over the combination of Burkhardt and Cohen.

VIII. DECISION

We affirm the Examiner's rejection of claims 1 through 3, 5 through 13, 15 through 23, and 25 through 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

nhl

HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720